

## **REMARKS**

Applicants have amended their claims, prior to examination of the above-identified application, in order to further clarify the definition of the present invention.

Specifically, Applicants are canceling claims 1, 2, 5-9, 14-16 and 18 without prejudice or disclaimer; and have amended claim 10 (the sole remaining original independent claim) to recite that the polyimide precursor is produced using (a) an oxydiphthalic acid or acid anhydride thereof as a reactant for forming the polyimide precursor, and (b) at least one diamine selected from a specific group thereof. In light of canceling of original claims 1 and 2, dependencies of claims 3 and 4 have been amended; in addition, in light of canceling of claim 14, dependency of claim 17 has been amended.

In addition, Applicants are adding new claims 19-23 to the application. Claims 19-22 further define the at least one diamine, with claims 20 and 21 reciting that the at least one diamine includes a diaminopolysiloxane represented by a specified formula.

Independent claim 23 defines a photosensitive resin composition corresponding to that in claim 10, but recites that the at least one diamine includes a hydroxyl group-containing diamine.

In connection with amendments to original claims, and in connection with the newly added claims, note, inter alia, the description in Applicants' specification in connection with the diamine used in producing the polyimide precursor, e.g., from page 8, line 25 to page 10, line 24, of Applicants' specification.

The undersigned respectfully directs the Examiner's attention to U.S. Patent No. 5,472,823 to Hagiwara, et al., applied by the Examiner in rejecting claims, for

example, in the Office Action mailed December 16, 2002, in prior Application No. 09/482,859, filed January 14, 2000. Noting the diamines recited in the present claims, used in forming the polyimide precursor, it is respectfully submitted that the teachings of U.S. Patent No. 5,472,823 would have neither disclosed nor would have suggested the photosensitive resin composition as in the present claims, including the polyimide precursor produced using, inter alia, the at least one diamine as in the present claims.

In any event, attention is respectfully directed to the effective filing date of the above-identified application (that is, September 2, 1994); and the filing date of the above-identified application (that is, November 17, 2003). Note also that U.S. Patent No. 5,472,823 has a patent date of December 5, 1995, after the effective filing date for the above-identified application. Thus, it is respectfully submitted that U.S. Patent No. 5,472,823 qualifies as prior art, at most, under 35 USC §102(e).

Furthermore, it is hereby stated by the undersigned that the above-identified application, Application No. 10/713,036, and U.S. Patent No. 5,472,823, were, at the time the invention of No. 10/713,036 was made, owned by Hitachi Chemical Co., Ltd. **The foregoing sentence constitutes a clear statement of common ownership.**


It is respectfully submitted that the foregoing clearly establishes that U.S. Patent No. 5,472,823 is disqualified as prior art under 35 USC §103, with respect to the presently claimed subject matter. Therefore, it is respectfully submitted that any question concerning whether the disclosure of U.S. Patent No. 5,472,823 would have suggested the presently claimed subject matter under 35 USC §103 is moot.

Entry of the present amendments, and subsequent thereto, examination of

the above-identified application in due course, are respectfully requested.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 511.33114CC6), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William I. Solomon", with a long horizontal flourish extending to the right.

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